

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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MAR 11 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MEHMET R. ARAS

Appeal No. 2004-2307
Application No. 09/331,756

ON BRIEF

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DIRECTOR OFFICE
TECHNOLOGY CENTER 2000

Before KRASS, GROSS, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 38-59, which are all the claims remaining in the application.

We reverse, and enter a new ground of rejection in accordance with 37 CFR § 41.50(b).

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BACKGROUND

The invention relates to a TV broadcast system whereby remote TV transmitters, and their transmitted content, may be controlled by a central studio. Claim 38 is reproduced below.

38. A TV broadcast method for a system to be operated from a TV continuity studio within the control of a broadcast flow unit, said method comprising:

- (a) generating alphanumeric characters and/or image data separately for each of plural remote sites at a central site and transmitting said alphanumeric characters and/or image data therefrom to said plural remote sites via a digital data communication link;
- (b) detecting whether said alphanumeric characters and/or image data have been received correctly at the said remote sites via said link;
- (c) generating and transmitting command codes within non-displayed portions of broadcast television signals to remotely control each of said remote sites from the said central site;
- (d) converting said alphanumeric characters and/or image data to local vision materials with a graphic generator at each of said remote sites;
- (e) at each remote site, overlaying said local vision material synchronously onto the continuing general television signal without cutting off the main general broadcast; and
- (f) detecting whether the said local vision materials have been broadcast via transmission of digital information sent back to the central site.

The examiner relies on the following references:

Harvey et al. (Harvey)	4,694,490	Sep. 15, 1987
Seth-Smith et al. (Seth-Smith)	4,829,569	May 9, 1989
Nemirofsky	5,412,416	May 2, 1995 (filed Aug. 7, 1992)

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Claims 38-41, 44, 47-49, 51, 53, and 56-59 stand rejected under 35 U.S.C. § 102 as being anticipated by Nemirofsky.

Claims 42 and 50 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nemirofsky and Seth-Smith.

Claims 43, 45, 46, 52, 54, and 55 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nemirofsky and Harvey.

We refer to the Final Rejection (Paper No. 20) and the Examiner's Answer (Paper No. 25) for a statement of the examiner's position and to the Brief (Paper No. 24) for appellant's position with respect to the claims which stand rejected.

OPINION

Rejections over the prior art

Instant claim 38 requires, *inter alia*, generating alphanumeric characters and/or image data separately for plural remote sites at a central site, and transmitting the data to the remote sites via a digital data communication link. The claim further requires generating and transmitting command codes within non-displayed portions of broadcast television signals to remotely control each of the remote sites from the central site.

The statement of the rejection (Answer at 4) points to Figure 2, element 46, and column 7, lines 35 through 44 of Nemirofsky as corresponding to the transmission of the data via a digital data communication link. The rejection further points to column 6 of the reference for a teaching of generating and transmitting command codes within

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non-displayed portions of the broadcast signals; i.e., within the vertical blanking interval (VBI) that is specific to Nemirofsky's analog environment. (Id.) The examiner underscores, later in the Answer, that the teaching of encoding control data in the VBI is deemed to correspond to the claimed generation and transmission of command codes within non-displayed portions of broadcast television signals. (Id. at 12.)

Nemirofsky describes two embodiments of the invention. In the analog (or "first") embodiment, video signals are transmitted in analog form. Col. 6, I. 8 et seq. In the analog embodiment, control data may be encoded in a vertical blanking interval in the analog video signal. Alternatively, the control data may be encoded into a separate data sub-carrier signal. Col. 6, II. 31-35.

In the digital embodiment, video data are compressed and transmitted in digital source channels. Col. 6, I. 52 et seq. Control data are carried on a digital control data channel. Col. 6, II. 52-59; col. 7, II. 31-37.

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). The rejection over Nemirofsky, however, reads the claimed elements on two distinct embodiments described in the reference. The rejection combines the teaching of a digital data communication link in Nemirofsky's digital embodiment with the teaching of transmitting command codes within non-

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displayed portions of broadcast television signals (i.e., in a vertical blanking interval) in the analog embodiment.

Reading a claim on separate embodiments described in a reference, while not consistent with a finding of anticipation, could support a rejection for obviousness. Whether there is suggestion to combine elements or steps of different embodiments is an inquiry under obviousness, rather than anticipation. “Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

In this case, however, we find no suggestion in Nemirofsky for combining the relevant portions of the distinct embodiments such that the requirements of instant claim 38 are met. Indeed, it appears that such a combination of the digital and analog embodiments of the reference would be, at best, impractical.

The remainder of the independent claims contain similar limitations to those of claim 38 that we have addressed. The additional references applied in the § 103 rejections do not remedy the basic deficiency of Nemirofsky as applied against the base claims. We thus do not sustain any of the rejections of the claims under 35 U.S.C. § 102 and 103.

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New ground of rejection

We enter the following new ground of rejection against the claims in accordance with 37 CFR § 41.50(b): Claims 38-59 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure fails to provide written description for the invention now claimed.

Each independent claim (e.g., claim 38) requires, inter alia, generating alphanumeric characters and/or image data separately for plural remote sites at a central site, and transmitting the data to the remote sites “via a digital data communication link.” The disclosure does not provide written description for the invention now claimed.

To comply with the “written description” requirement of 35 U.S.C. § 112, first paragraph, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the “written description” inquiry, whatever is now claimed.

Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). To “convey with reasonable clarity to those skilled in the art” may also be expressed in terms of whether the “necessary and only reasonable construction” to be given the disclosure by one skilled in the art clearly supports the limitation now claimed.

See Hyatt v. Boone, 146 F.3d 1348, 1354, 47 USPQ2d 1128, 1132 (Fed. Cir. 1998) (“We do not view these various expressions as setting divergent standards for compliance with § 112. In all cases, the purpose of the description requirement is ‘to

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ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him."") (quoting In re Edwards, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978)).

The invention claimed does not have to be described in ipsius verbis in order to satisfy the written description requirement. Union Oil Co. v. Atlantic Richfield Co., 208 F.3d 989, 1000, 54 USPQ2d 1227, 1235 (Fed. Cir. 2000). However, one skilled in the art, reading the original disclosure, must be able to immediately discern the limitations now claimed. See Waldemar Link GmbH & Co. v. Osteonics Corp., 32 F.3d 556, 558, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994) ("The fact finder must determine if one skilled in the art, reading the original specification, would immediately discern the limitation at issue in the parent.").

We are mindful, however, that the question of written description support should not be confused with the question of what would have been obvious to the artisan. Whether one skilled in the art would find the instantly claimed invention obvious in view of the disclosure is not an issue in the "written description" inquiry. In re Barker, 559 F.2d 588, 593, 194 USPQ 470, 474 (CCPA 1977). A description which renders obvious the invention for which the benefit of an earlier date is sought is not sufficient. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

When a claimed limitation is not present in the written description, it must be shown that a person of ordinary skill would have understood, at the time the application

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was filed, that the description requires that limitation. See Hyatt v. Boone, 146 F.3d at 1353, 47 USPQ2d at 1131 ("[W]hen an explicit limitation in an interference count is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation.").

One shows "possession" by descriptive means such as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. Lockwood, 107 F.3d at 1572, 41 USPQ2d at 1966. It is not sufficient for purposes of the written description requirement that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose. Id.

Appellant's disclosure described alphanumeric character and/or image data, stored as data files on hard disk at the central site, and later transmitted to a remote station over a modem. The modem/telephone network communications link to the remote stations was deemed to be the most reliable link for data transfer. (See, e.g., spec. at 6.)

Modem communication over a telephone network is not, however, a digital data communication link, as now claimed. A modem is "[a] device that converts the digital signals produced by terminals and computers into the analog signals that telephone circuits are designed to carry." McGraw-Hill Encyclopedia of Science & Technology, 7th

ed., vol. 11, at 313 (1992).¹ The disclosure thus described an analog, rather than digital, communication link.²

We acknowledge that, at the time of invention, there may have been devices referred to as "digital modems," or other instances of equipment having designations that included the term "modem," that may have been useful for digital communication links. The modem described in the instant specification, however, is simply a "modem" -- not modified by other terms so as to describe some other piece of equipment.

Moreover, as we have suggested supra, the question of whether it would have been obvious to use a digital, as opposed to an analog, communication link is not at issue in the present inquiry. The question of whether appellant may have contemplated other embodiments, not described, is not at issue in the present inquiry.

CONCLUSION

The rejection of claims 38-59 under 35 U.S.C. § 102 or 103 is reversed. A new rejection of claims 38-59 under 35 U.S.C. § 112, first paragraph is set forth herein.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz.

¹ A copy of the reference, pages 313 and 314, should mail as an attachment to this decision.

² To the extent that the disclosure may have conveyed that the relevant data transmission could be via satellite (e.g., original claim 2), there was no disclosure of, at the least, digital transmission of the alphanumeric characters and/or image data via satellite in combination with generation and transmission of command codes within non-displayed portions of broadcast television signals.

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Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). See 37 CFR § 1.136(a)(1)(iv).

REVERSED -- 37 CFR § 41.50(b)


ERROL A. KRASS
Administrative Patent Judge

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HOWARD B. BLANKENSHIP
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